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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,395	03/09/2001	Steven Spielberg	80700.911	7561

22804 7590 10/23/2006

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EXAMINER

HUTTON JR, WILLIAM D

ART UNIT PAPER NUMBER

2176

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/802,395

Applicant(s)

SPIELBERG, STEVEN

Examiner

Doug Hutton

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 60-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 60-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Applicant's Response

In Applicant's Response dated 08/11/2006, Applicant added new Claims 60-68, cancelled Claims 1-59, and argued against all objections and rejections previously set forth in the Office Action dated 04/07/2006.

In light of Applicant's cancellation of Claims 1-59, all claim objections and rejections previously set forth are withdrawn.

Specification

The disclosure is objected to because of the following informalities:

- The sentence "For example, if annotation device 401 comprises a smart mobile client device 401 should have the computational power to perform the annotating functions described in FIG. 5 in addition to the control functions 502 for playback of the original document." on Page 24, Lines 12-15 should be amended because it is not grammatically correct in that the verb phrase "should have" does not have a subject.

Appropriate correction is required.

Claim Objections

Claim 60 is objected to because of the following informalities:

- The phrase "*annotations information records*" in Lines 3, 4, 7 and 16 (4 instances) should be amended to — annotation files — because that is how the element is identified in the Specification (see Page 29, Lines 13-14).
- The phrase "*generate a **relationship information** between said audio comment and said audio source*" in Lines 13-14 should be amended to — associate said audio comment with the point at which said audio comment was made during said playback of said audio source — to more clearly describe how the invention works. Additionally, the phrase "*relationship information*" is not mentioned in the original Specification.

Appropriate correction is required.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference signs mentioned in the description:

- 1300-1312 (see Specification – Page 48, Lines 4-18).

Applicant may obviate this rejection by amending Figure 13 of the drawings to include the reference numbers discussed in the Specification.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 60-68 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 60-68:

Claim 60 recites the limitation "*a document processing engine configured to obtain . . . a **subset** of said plurality of annotations information records from said storage medium*" [emphasis added] (see Lines 6-8). There is no mention in the original

Specification of obtaining only a **subset** of the total annotations for a retrieved document.

If the examiner has overlooked the portion of the original Specification that describes this feature of the present invention, then Applicant should point it out (by page number and line number) in the response to this Office Action.

Claims 61-68 are dependent upon Claim 60 and thus include the same problem.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 60, 61 and 63-68 are rejected under 35 U.S.C. 102(b) as being anticipated by Logan et al., U.S. Patent No. 5,732,216.

Claim 60:

Logan discloses *a smart mobile apparatus for annotating a document* [see Column 1, Lines 42-65; see Column 3, Lines 24-41; see Column 6, Line 36 through Column 7, Line 2 → Logan discloses this limitation in that the system allows a user to record an annotation/comment for a text document using a mobile computing device], *comprising:*

- *a data storage medium configured for storing a text document and a plurality of annotations information records* [see Figure 1; see Column 3, Line 24 through Column 4, Line 3 → Logan discloses this limitation, as clearly indicated in the cited figure and text], *wherein said plurality of annotations information records is linked in a hierarchical tree structure to said text document* [see Column 1, Lines 50-65; see Column 12, Line 59 through Column 13, Line 22; see Column 19, Lines 23-43; see Column 41, Line 44 through Column 42, Line 27 → Logan discloses this limitation in that the system allows users to comment upon other users' comments. This feature enables public interchanges to take place in publicly available threads that are analogous to Internet newsgroups, which operate in a hierarchical tree structure. Also, Logan discloses this limitation in that the system stores the text document and all annotations/comments associated with the document in a hierarchical tree structure having a parent/child relationship. That is, the text document is the "parent" and the annotations/comments are the "children." Because the system allows users to comment on other users' comments, the hierarchy comprises multiple hierarchical levels of comments.];
- *a document processing engine configured to obtain said text document and a subset of said plurality of annotations information records from said storage medium for synchronous playback as an audio source* [see Column 1, Line 41 through Column 2, Line 9; see Column 3, Lines 37-41; see Column 4, Lines 26-36; see Column 4, Lines 40-52; see Column 5, Lines 16-31 → Logan discloses

this limitation in that the system comprises a processor that is configured to retrieve the document, convert it to audio and play the converted document and a subset of the associated annotations to the user. The system allows users to limit access to their comments. Thus, the system discloses obtaining a “subset” of the “*plurality of annotations*” in that a text document may comprise both “public” and “private” annotations/comments. In this case, the “public” annotations/comments would be retrieved and played back to the requesting user, whereas the “private” annotations/comments would not.];

- *an audio playback interface configured for controlling playback of said audio source by a user* [see Column 3, Lines 24-41; see Column 12, Line 52 through Column 15, Line 63 → Logan discloses this limitation in that the system, while the audio is being played to the user, is configured to allow the user to control playback of the converted document and the associated annotations/comments];
- *an audio input device configured to obtain at least one audio comment from said user* [see Column 12, Line 52 through Column 13, Line 22; see Column 15, Lines 10-46 → Logan discloses this limitation in that the system, while the audio is being played to the user, is configured to allow the user to orally dictate an annotation/comment]; *and*
- *an annotator configured to generate a relationship information between said audio comment and said audio source* [see Column 12, Line 52 through Column 13, Line 22; see Column 15, Lines 10-46; see Column 19, Lines 25-43; see Column 40, Line 58 through Column 41, Line 47 → Logan discloses this

limitation in that the system is configured to associate the user's annotations/comments with particular portions of the text document about which the annotations/comments are concerned], *said annotator further configured to save said audio comment and said relationship information in a subset of said plurality of annotations information records* [As indicated in the above discussion, Logan discloses that the system allows users to comment upon other users' comments. Thus, the system is configured to save the user's annotations/comments, and the associated particular portions of the text document, in a "*subset of said plurality of annotations information records*."].

Claim 61:

Logan discloses *the apparatus of Claim 60, wherein said data storage comprises removable media* [see Column 6, Lines 58-61 → Logan discloses this limitation in that the system downloads the text documents onto a disk, which allows portable use of the text document].

Claim 63:

Logan discloses *the apparatus of Claim 60, wherein said audio source comprises a streaming media file* [see Column 4, Lines 4-16 → Logan discloses this limitation in that the system plays downloaded files in a streaming format].

Claim 64:

Logan discloses *the apparatus of Claim 60, wherein said relationship information comprises an index identifier for said comment* [As indicated in the above discussion, Logan discloses that the system associates the user's annotations/comments with particular portions of the text document about which the annotations/comments are concerned].

Claim 65:

Logan discloses *the apparatus of Claim 60, wherein said relationship information comprises identification data of said user* [see Column 19, Lines 23-42 → Logan discloses this limitation in that the system stores data that identifies the user making the annotation/comment].

Claim 66:

Logan discloses *the apparatus of Claim 60, wherein said annotations information records comprises a plurality of name records, wherein each of said plurality of name records includes an associated plurality of index and comment records* [As indicated in the above discussions, Logan discloses that the system stores data that identifies the user making the annotation/comment, associates the user's annotation/comment with the particular portion of the text document about which the annotation/comment is concerned and allows users to comment upon other users' comments. Thereby, the system stores a plurality of user comments about particular portions of a document in a

hierarchical tree structure comprising multiple hierarchical levels of user comments.

Thus, each comment record (i.e., "*annotations information record*") saved by the system includes a "*name record*," and each "*name record*" includes multiple associated comments (i.e., "*comment records*") that are stored in a hierarchy, wherein each associated comment comprises data indicating the particular portion of the text document about which the comment is concerned (i.e., "*index record*").].

Claim 67:

Logan discloses *the apparatus of Claim 66, wherein said hierarchical tree structure comprises:*

- *said text document as said top level;*
- *said plurality of name records as a next lower level; and*
- *followed by said plurality of index and comment records* [Logan discloses these limitations in that, as indicated in the above discussions, the system stores the text document and all annotations/comments associated with the document in a hierarchical tree structure having a parent/child relationship, wherein the text document is the "parent" and the annotations/comments are the "children."

Because the text document is the "parent" (i.e., "top level") and the annotations/comments are "children" (i.e., "next lower level") upon which other users may comment, these limitations read on the system.].

Claim 68:

Logan discloses *the apparatus of Claim 60, wherein said subset of said plurality of annotations information records is selectable by said user* [see Column 7, Line 5 through Column 8, Line 60; see Column 19, Lines 23-43 → Logan discloses this limitation in that the system stores all data regarding the annotations/comments and allows the user to select text documents for playback based on the data].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over Logan, in view of Merrill et al., U.S. Patent No. 6,181,351.

Claim 62:

As indicated in the above rejection, Logan discloses every element of Claim 61.

Logan fails to expressly disclose *a removable memory comprising flash memory*.

Merrill teaches *an annotator* [see Column 7, Lines 12-15 – Merrill discloses this limitation in that the system is used to annotate a speech sound data stream] *having*

removable memory that comprises flash memory [see Column 5, Lines 32-37 – Merrill discloses this limitation in that the system comprises many different types of computer memory, including flash memory], for the purposes of recording, storing and editing audio files [see Column 9, Lines 20-51].

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus, disclosed in Logan, to include *a removable memory comprising flash memory*, for the purpose of recording, storing and editing audio files, as taught by Merrill.

Response to Arguments

Applicant's arguments filed 08/11/2006 have been fully considered but they are not persuasive.

Rejection of Claims Under 35 U.S.C. § 102(b):

Applicant argues that Logan is "distinguishable" from the present invention because it "contemplates a communications link between a user interface device (player 103) with a host computer (i.e. 101), which is located elsewhere." Applicant argues further that Logan's host computer provides all the document processing needed for management of annotations, whereas the claimed invention comprises a smart portable

device that performs all of the document processing and content management. See *Response* – Page 5, third paragraph.

The examiner disagrees.

The examiner notes that the features upon which Applicant relies (i.e., all document processing and content management are performed within the portable device) are not recited in the rejected claims. Although the claims are interpreted in light of the Specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Logan discloses that the system may comprise a “*mobile*” apparatus that performs at least a portion of the document processing and content management. Thus, the entire system of Logan may reasonably be considered a “*smart mobile apparatus*” that includes the elements recited in Claim 1.

Applicant argues that Logan does not teach that the annotations are linked to the text document in a “hierarchical tree structure.” Applicant provides no analysis of the claim language with respect to the disclosure of Logan. Rather, Applicant simply asserts the “hierarchical tree structure” is not disclosed in Logan. See *Response* – Page 5, fourth paragraph.

The examiner disagrees.

Firstly, Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made.

Applicant provides no analysis of the recited limitation in view of the subject matter disclosed in the cited reference. Instead, Applicant simply states, "it's not there."

Secondly, the examiner notes that the feature upon which Applicant relies (i.e., a "hierarchical tree structure" in the smart device) is not recited in the rejected claims. Although the claims are interpreted in light of the Specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Thirdly, Logan discloses a "*hierarchical tree structure*," as indicated in the above rejection for Claim 1. The examiner will not repeat the explanation here.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is 571-272-4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

WDH
October 19, 2006



Doug Hutton
Primary Examiner
Technology Center 2100